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SEND TO: United States Patent Office
Examiner: Kyle R. Stork
Group Art Unit: 2178
Tel No: _____
Fax #: 512-273-8300

FROM: J.B. KRAFT
Tel No: 512-473-2303

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Docket No. AUS920010344V51 Serial No. 09/451 Y5F Atty: J.B. KRAFT
Applicant: G.F. McPherson et al

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : Group Art Unit: 2178
Gerald P. McBrearty et al. : Intellectual Property
Serial No: 09/899,454 : Law Department - 4054
Filed: 07/05/2001 : International Business
Title: BOOKMARKS FOR WORLD : Machines Corporation
WIDE WEB DOCUMENTS WITH : 11400 Burnet Road
INDICATORS OF THE HIT RATES : Austin, Texas 78758
FOR THE WEB DOCUMENTS FROM : CUSTOMER NUMBER 32,329
THE WEB SITES SENDING THE :
DOCUMENTS :
Date: 08/14/06 :

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence including the present Reply Brief (in triplicate) is being transmitted via facsimile to USPTO, Group Art Unit 2178 at telephone number 571-273-8300, and to the attention of Examiner Kyle R. Stork on 08/14/06.

REPLY BRIEF ON APPEAL
BEFORE THE BOARD OF APPEALS
AND INTERFERENCES

Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Reply Brief to the Examiner's Answer mailed June 14, 2006.

In the Answer, the Examiner makes a fresh argument which Applicants wish to address.

AUS920010344US1

PATENT
09/899,454

The present invention addresses the problem of delays associated with the accessing of bookmarked Web documents due to the high "hit" rates (numbers of Web document requests) to the Web sites providing such documents. The invention solves this problem by providing at a receiving i.e. Web document requesting station, in association with a displayed list of bookmarks for Web documents, displayed data on the rates of transmission (hit rates) of each listed bookmarked Web document. In this way, the user at the receiving station may judge before requesting a listed bookmarked Web document whether a high transmission rate will mean a delay in accessing a particular bookmarked Web document.

In developing his argument, Examiner looks to a patent, Ryan et al. which is not concerned with bookmarking of already known Web documents at a user's Web terminal but rather is concerned with search algorithms for searching for and locating unknown Web documents. The present invention is completely unrelated to searching. It is submitted that one skilled in the art would be unlikely to even consider a reference like Ryan which describes a complex search engine for finding Web documents of interest to the user.

In his search algorithms, Ryan uses many lists of potential Web sites (sources of Web documents). Applicants submit that even if Ryan's lists would be combined for the purpose of searching, there would still be no suggestion of the claimed:

"...displaying in association with a displayed list of bookmarks for Web documents, data on the rates of transmission of said bookmarked documents at the time of said display."

Among the many lists used in Ryan's search engines, the Examiner points out a list of Web sites ranked according to hit rate (Col. 7, lines 22-35, high flyers) which he

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The cited "High-fliers" hit list in Ryan is a standard search expedient i.e. the more popular a Web site is, the more likely it is to include a Web document of specific interest. This search expedient for finding Web document would not suggest to one skilled in the art, any reason for listing the transmission or hit rates for each of already found bookmarked Web documents.

In this connection, Examiner points to Ryan's reference to the term "bookmarking" in "personal hit" list of the user (Col. 7 lines 37-40). This personal hit list refers to a list of Web sites which the user has found useful in the past for each respective key word to be searched. The section states that this list for each key word to be searched is "like an automatic bookmarking data set for each individual user".

Applicants submit that this use of "like....bookmarking" has nothing with an actual bookmarked Web document. It is a Web searching expedient for relating a group of potential Web sites to be searched in attempting

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Applicants submit that in his picking and combining elements in Ryan in an attempt to show obviousness, the Examiner is doing so not based upon any suggestion in Ryan but rather in the light of Applicants' own teaching. This approach cannot be used to render Applicants' invention unpatentable.

The Examiner has used Applicants' own disclosure as a guideline, and the picked and combined elements from the Ryan reference based solely of Applicants' own teaching.

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art references of record convey nor suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore, 721 F 2d at 1553, 220 USPQ, pp. 312-313.

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 5 USPQ 2d 1596 (C.A.F.C.) 1988.

As set forth in the Brief on Appeal, the Pitkow publication fails to make up for these deficiencies in the basic Ryan reference. All Pitkow appears to discuss in Section (0136) cited by Examiner is the vague and general concept that bookmarked Web documents at a receiving Web station may be categorized. Again, this is quite remote from, and not suggestive of displaying such activity rates in association with a list of displayed bookmarked documents at a receiving Web station.

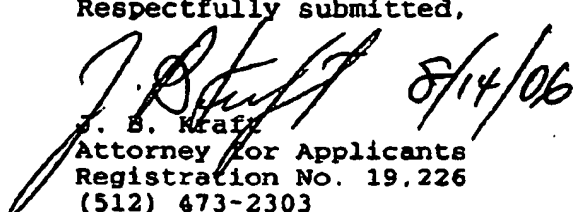
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Accordingly, for the above reasons and for the reasons set forth in the Brief on Appeal, it is respectfully requested that the Final Rejection be reversed, and that claims 1-36 be found to be in condition for allowance.

Respectfully submitted,

 8/14/06
J. B. Kraft
Attorney for Applicants
Registration No. 19,226
(512) 473-2303

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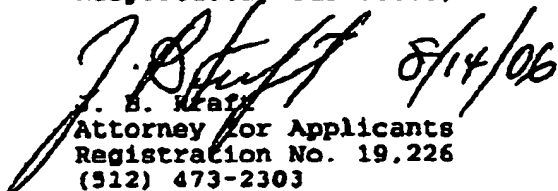
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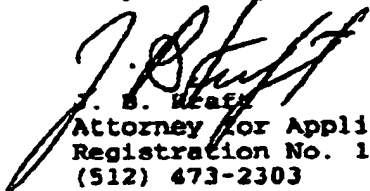
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